they be statutory double patenting of the cited claim. The rejection cannot be maintained under 35 U.S.C. § 101 because the none of the individual claims of claims 27-29 in the present application are identical to the cited claim.

The test for statutory double patenting is whether the same invention, i.e. identical subject matter, is being claimed twice. See MPEP 804(II)(A) and cases cited therein. "A good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other." *See id.* and *In re Vogel*, 422 F.2d 438, 441 (CCPA 1970). This means that the same invention comparison must be made between two claims, i.e. one claim and another.

Under this test, a rejection of claims 27-29 should have been the result of (1) claim 27 being compared against the cited claim; (2) claim 28 being compared against the cited claim; and (3) claim 29 being compared against the cited claim. Clearly none of these 3 comparisons would have led to the conclusion that the cited claim is the same as any one of claims 27-29 because the claim scope is not identical between any of these three pairings. The non-identical claim scope means that one of the claims in each of the three comparisons above could be infringed without literally infringing the other.

To the extent suggested otherwise by the Office Action, claims may not be combined to create the "same invention" as another single claim. A combination of claims to form a basis for a statutory double patenting is improper under the "same invention" standard enunciated in *In re Vogel* because each claim, i.e. each invention, must be compared against one other claim. Applicant does not address whether a combination of claims 27-29, i.e. a combination of those inventions, would be the "same invention" as the cited claim and does not admit or acquiesce to any suggestion or conclusion in the Office Action that such would be the case.

Thus, (1) none of claims 27-29 are identical to (or claim the "same invention" as) claim 8 of U.S. Patent No. 5,824,485, and (2) claims 27-29 cannot be rejected for statutory double patenting based upon their comparison to the cited claim in combination

together. Accordingly the statutory double patenting rejection should be reconsidered and withdrawn.

CONCLUSION

The foregoing remarks show that claims 27-29 are not duplicative of claim 8 of U.S. Patent No. 5,824,485 under a proper statutory double patenting analysis. With no further basis for rejection given, allowance is respectfully requested.

The Office Action provided three months for a response, and Applicants are concurrently filing a Petition for a One Month Extension of Time. The last day for responding to the Office Action with the one-month extension is February 7, 2004, which falls on a Saturday. Pursuant to 37 C.F.R. § 1.7, applicants may submit this response on the next business day, i.e. February 9, 2004.

No fee (other than the fee being paid with the Petition for a One Month Extension of Time) is believed necessary, however, the Commissioner is authorized to deduct any deficient amount or credit any surplus amount to Deposit Account No. 50-1986.

Respectfully submitted,

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